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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,378	12/12/2001	James Sheung Lau	CA920000074US1 (7161-208U	2828

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EXAMINER	
SIMITOSKI, MICHAEL J	

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/015,378	LAU, JAMES SHEUNG	
	Examiner	Art Unit	
	Michael J. Simitoski	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13,15-29 and 31-39* is/are pending in the application.

4a) Of the above claim(s) *25-28 and 36-39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13,15-22,25-29 and 31-39* is/are rejected.

7)☐ Claim(s) *23 and 24* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 March 2002* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The response of 7/24/2006 was received and considered.

2. Claims 1-13, 15-29 & 31-39 are pending.

3. Claims 25-28 & 36-39 are withdrawn from consideration.

Response to Arguments

4. Applicant's arguments with respect to claims 1-13, 15-29 & 31-39 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's response (pp. 11-15) argues that Snyder and Colvin fail to disclose non-functional descriptive content. However, Meyer teaches that it is known and beneficial to embed executable code in non-functional descriptive media such as video or audio media (col. 4, lines 32-40 & col. 5, line 59 – col. 1, line 3) for the purposes of controlling the environment in which the media is being used (col. 10, lines 42-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify either Snyder or Colvin to embed the access control program for encouraging users to register (in the case of Snyder or Colvin) software in non-functional descriptive media according to the teachings of Meyer to similarly control the usage of the non-functional descriptive media and to gain the benefit of statistical tracking of media.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1-13, 15, 19-20, 29 & 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,070,171 to Snyder et al. (**Snyder**) in view of U.S. Patent 6,748,362 to Meyer et al. (**Meyer**).

Regarding claims 1, 3, 6, 10-11, 15, 19-20, 29 & 32-35, Snyder discloses embedding in computer readable content/software (col. 2, lines 25-28 & col. 12, lines 21-25), instruction codes operable to direct a processor circuit to automatically establish a connection to a server (col. 12, lines 28-30), when said content/software is in use by said processor circuit (col. 12, lines 28-30), to transmit registration information/token to said server (col. 12, lines 28-30) and operable to control further use of said content/software by said processor circuit (Fig. 3a, #48) in response to a key/new token and permission received from said server (col. 12, lines 36-37 & Fig. 3a, #48). Snyder lacks the content being non-functional descriptive content. However, Meyer teaches that non-functional descriptive content (col. 4, lines 32-40 & col. 5, line 59 – col. 1, line 3) can have embedded therein executable code or application-specific data (col. 6, lines 43-55) for the purposes of execution of the code simultaneously with the use of the non-functional descriptive content to control the exact behavior of the execution environment relative to the content while playback is occurring (col. 10, lines 42-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Snyder to embed the Tracker client program and other required data into non-functional descriptive content. One of ordinary skill in the art would have been motivated to perform such a modification to control the exact behavior of the execution environment of the content and track usage of the content, as

taught by Meyer (col. 4, lines 32-40, col. 5, line 59 – col. 1, line 3, col. 6, lines 43-55 & col. 10, lines 42-53).

Regarding claims 2, 7 & 9, Snyder, as modified above, discloses a portable memory medium/CD-ROM (col. 11, lines 34-42 & col. 12, lines 12-15).

Regarding claims 4-5 & 31, Snyder, as modified above, discloses a self-executing applet/tracker client (col. 12, lines 12-15).

Regarding claim 8, Snyder, as modified above, discloses transmitting said computer readable content and said embedded instruction codes on a communications network/email (col. 12, lines 56-58).

Regarding claims 12-13, Snyder, as modified above, discloses producing a measure of use of said content/current token (col. 7, lines 20-21).

8. Claims 1-11, 16-20, 39 & 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2004/0225900 to **Colvin** in view of **Meyer**. Colvin teaches embedding, in computer readable content, instruction codes (¶29) operable to direct a processor circuit to automatically establish a connection to a server (¶29 & ¶32), when said content is in use by said processor circuit, to transmit registration information to said server (¶32), and operable to control further use of said content by said processor circuit in response to a key/authorization code (¶29 & ¶32-33), wherein the instruction codes/software include self-executing (installation) application code. Colvin lacks the content being non-functional descriptive content. However, Meyer teaches that non-functional descriptive content (col. 4, lines 32-40 & col. 5, line 59 – col. 1, line 3) can have embedded therein executable code

or application-specific data (col. 6, lines 43-55) for the purposes of execution of the code simultaneously with the use of the non-functional descriptive content to control the exact behavior of the execution environment relative to the content while playback is occurring (col. 10, lines 42-53). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Colvin to embed the Tracker client program and other required data into non-functional descriptive content. One of ordinary skill in the art would have been motivated to perform such a modification to control the exact behavior of the execution environment of the content and track usage of the content, as taught by Meyer (col. 4, lines 32-40, col. 5, line 59 – col. 1, line 3, col. 6, lines 43-55 & col. 10, lines 42-53).

9. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder** and **Meyer**, as applied to claim 12 above, in further view of U.S. Patent Application Publication 2003/0078853 to Peinado et al. (**Peinado**).

Regarding claim 16, Snyder lacks establishing a connection to said server when said measure of use exceeds a threshold value. However, Peinado teaches by including a license with a description of constraints to be met before content is rendered (¶18), a user is restricted to a limited number of uses of content (¶128 & ¶136). Peinado further discloses that the user can obtain additional access to the content by contacting the server to obtain a valid license (¶137 & ¶140). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Snyder to contact the server when a measure exceeds a threshold. One of ordinary skill in the art would have been motivated to perform such a modification to limit the number of uses of the content, as taught by Peinado (¶18, 128, 133-137 & 140).

Regarding claim 17, Snyder discloses an Internet protocol connection (col. 4, lines 40-43).

10. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder**, **Meyer** and **Peinado**, as applied to claim 17 above, in further view of U.S. Patent Application Publication 2002/0046181 to Story, Jr. et al. (**Story**). Snyder, as modified above, discloses a browse session with a uniform resource locator/web site pointing to a user registration page (¶140-¶141), but lacks explicitly the page permitting a user to enter registration information. However, Story teaches that it is known to use a web page to authenticate a user before supplying the user with a license (¶39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Snyder to use the web page supplied by the server to permit the user to enter registration information. One of ordinary skill in the art would have been motivated to perform such a modification to authenticate the user before authorizing the creation of a license, as taught by Story (¶39).

11. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder** and **Meyer**, as applied to claim 20 above, in further view of U.S. Patent 5,946,677 to **Bullen**. Snyder, as modified above, lacks deleting files produced by functional descriptive content in said computer readable content. However, Bullen teaches that it is well known for application programs to generate temporary files that are generally unneeded and which must later be deleted to free up additional storage capacity (col. 2, lines 12-15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify

Snyder to delete files produced by functional descriptive content/tracker client and software in said computer readable content/software. One of ordinary skill in the art would have been motivated to perform such a modification to free up additional storage capacity, as taught by Bullen (col. 2, lines 12-15).

12. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder**, **Meyer** and **Bullen**, as applied to claim 21 above, in further view of U.S. Patent 6,784,925 to Tomat et al. (**Tomat**). Snyder, as modified above, lacks warning a user of said processor circuit that files are about to be deleted. However, Tomat teaches that when temporary disk space runs low, it is beneficial to warn a user that files need to be deleted (col. 23, lines 11-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Snyder to warn the user when files are about to be deleted. One of ordinary skill in the art would have been motivated to perform such a modification to allow the user to choose to modify the temporary storage space, as taught by Tomat (col. 23, lines 11-16).

Allowable Subject Matter

13. Claims 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

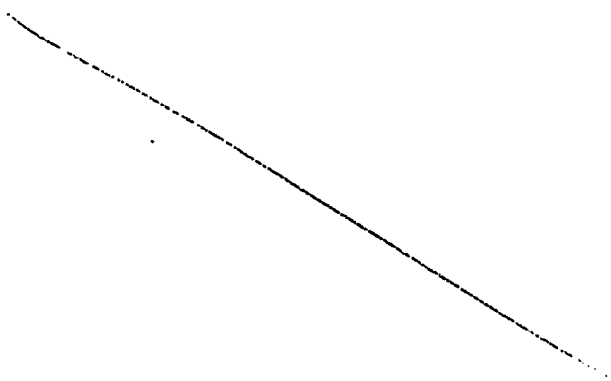
Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJS

September 20, 2006

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